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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,583	06/24/2003	Kimio Nagasaka	116034	8358

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EXAMINER

DOAN, JENNIFER

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/601,583	Applicant(s) NAGASAKA ET AL.	
	Examiner Jennifer Doan	Art Unit 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 15, 16, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>062403 & 121504</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of claims 1-5 and 14-20 in the reply filed on December 2, 2004, is acknowledged. The traversal is on the ground(s) that "the subject matter of all species is sufficiently related that a thorough search for the subject matter of any one species would encompass a search for the subject matter of the remaining species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden."

This is not found persuasive because this application is clearly directed to two distinct species:

- a) Embodiment I: figures 1(a), 1(b), 2(a), 2(b), 3, 4, 5(a)-5(e), 6(a)-6(b), 7-13, 14(a)-14(b), 15(a)-15(b) and 16-20.
- b) Embodiment II: figures 21, 22, 23(a)-23(f) and 24-27.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

1. The prior art documents submitted by applicant in the Information Disclosure Statements filed on 6/24/2003 and 12/15/2004, have all been considered and made of record (note the attached copy of form PTO-1449).

Drawings

2. The drawings, filed on 6/24/2003, are accepted.

Specification

3. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of

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35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3, 14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanisawa et al. (U.S. Patent 5,278,929) in view of Morton et al. (U.S. Patent 5,295,212).

With respect to claims 1, 14 and 17, Tanisawa et al. (figure 3) disclose a method and an apparatus of an alignment adjustment device for use with an object comprising an optical socket having a supporting body (42) and defining a fitting hole (see figure 3); an optical head inserted into the fitting hole of the optical socket, the optical head photographing the object around a bottom portion of the fitting hole and outputting an image of the object as a read signal together with information representing a photographing reference position; wherein the information representing the reference position being an alignment mark formed on one end face of a columnar body in the optical head, the face facing the object insert into the fitting hole of the optical socket (as shown in figure 3).

Tanisawa et al. do not disclose an image-processing device to process the read signal to detect a difference between the object and the reference position and move the supporting body and the optical socket relative to each other according to the difference.

However, Morton et al. (figure 8 and column 7, lines 28-51) disclose an image-processing device (as a computer systems) to process the read signal to detect a difference between the object and the reference position and move the

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supporting body and the optical socket relative to each other according to the difference. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Tanisawa to include an image processing device to process the read signal to detect a difference between the object and the reference position and move the supporting body and the optical socket relative to each other according to the difference (accordance with the teaching of Morton et al.) for the purpose of obtaining a better optical aligning and coupling and preventing as optical signal transmission loss.

With respect to claim 2, Tanisawa et al. disclose the method, wherein the assembling object including at least one of a light transmitting substrate and a can package (see figure 3).

With respect to claims 3 and 18, Tanisawa et al. (figures 3 and 6) disclose an apparatus and the method, wherein the image of the assembling object including at least one of a wiring pattern, a positioning mark, a positioning hole (see figures 3 and 6), a light-emitting element (74), a light-receiving element (82), a lens (78, 80) and a window of the can package which are formed on the assembling object (as shown in figure 3 and 6).

Allowable Subject Matter

7. Claim 4, 5, 15, 16, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to disclose or reasonably suggest an apparatus and a method of manufacturing an optical transceiver comprising the reference position information being a marker representing a screen central position of the photographed image as recited in claims 4, 15 and 16; and the mounting including disposing an image formation position adjustment lens to adjust an image-formation position of the image between the optical head and the assembling object to as to obtain the image of the assembling object as recited in claims 5 and 19.

Claim 20 is dependent on the objected claim 19; therefore, claim 20 is also objected.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Doan whose telephone number is (571) 272-2346. The examiner can normally be reached on Monday to Thursday from 6:00 am to 3:30 pm, second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Jennifer Doan".

Jennifer Doan

Patent examiner

March 3, 2005